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EXAMINER

FERGUSON, MICHAEL P

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Please find below and/or attached an Office communication concerning this application or proceeding.

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/074,496
Filing Date: May 07, 1998
Appellant(s): ALBRITTON, JAMES R.

Chad C. Walters
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed March 29, 2010 appealing from the Office action mailed September 3, 2009.

(1) Real Party in Interest

The examiner has no comment on the statement, or lack of statement, identifying by name the real party in interest in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The following is a list of claims that are rejected and pending in the application:

Claims 37 and 40 are pending and stand rejected.

(4) Status of Amendments After Final

The examiner has no comment on the appellant's statement of the status of amendments after final rejection contained in the brief.

(5) Summary of Claimed Subject Matter

The examiner has no comment on the summary of claimed subject matter contained in the brief.

However, Examiner notes that the summary of claimed subject matter fails to properly identify each claimed element by reference numeral, with reference to the appropriate figure and the specification by page and line number for each element.

(6) Grounds of Rejection to be Reviewed on Appeal

The examiner has no comment on the appellant's statement of the grounds of rejection to be reviewed on appeal. Every ground of rejection set forth in the Office

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action from which the appeal is taken (as modified by any advisory actions) is being maintained by the examiner except for the grounds of rejection (if any) listed under the subheading "WITHDRAWN REJECTIONS." New grounds of rejection (if any) are provided under the subheading "NEW GROUNDS OF REJECTION."

(7) Claims Appendix

The examiner has no comment on the copy of the appealed claims contained in the Appendix to the appellant's brief.

(8) Evidence Relied Upon

4,183,695

WILCOX

1-1980

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 37 and 40 are rejected under 35 U.S.C. 102(b) as being anticipated by Wilcox (US 4,183,695).

At the outset, it is well-established that a recitation with respect to the manner in which a claimed device is intended to be used does not differentiate the claimed device from the prior art device when the prior art device teaches all of the structural limitations of the claims. See *Ex parte Masham*, 2 USPQ2d 1647 (BPAI 1987). Further, it is also

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well-established that for anticipation to exist, it is only necessary that the claims “read on” something disclosed in the prior art reference. See *Kalman v. Kimberly-Clark Corp.*, 713 F.2d 760, 772, 218 USPQ 781, 789 (CAFC 1983), cert. denied, 465 U.S. 1026 (1984).

As to claim 37, Wilcox discloses a breakaway guardrail post **10** used in a vehicle barricade. The intended use recitation of “for highway crash control systems” is but one possible field of use that otherwise does not serve to structurally define and limit the claimed post. Nevertheless, the “vehicle barricade” use disclosed by Wilcox constitutes a “highway crash control system” within the breadth of the claim. The post of Wilcox comprises:

an upper post member **24,26** having a weak impact axis and a strong impact axis;

a lower post member **12** disposed beneath and spaced apart from the upper post member (lower member **12** together with upper member **24,26** form post **10**; thus lower member **12** constitutes a “post member”; Figure 1);

a connecting joint member **30,32** having a first end and a second end, the first end of the joint member connected at the first end by a first fastener **40,42** to the upper post member and connected at the second end by an attachment to the lower post member (joint member **30,32** is connected by a welded attachment to lower post member **12**; column 1 lines 62-65), the first fastener having a first failure strength less than a second failure strength of the attachment;

the first fastener having a first connector **40** having a first failure strength and a second connector **42** having a second failure strength; and

the first failure strength of the first connector greater than the second failure strength of the second connector such that upon an impact force being applied along the weak impact axis, the second connector fails and the upper post member rotates about the first connector (Figures 1-6).

Examiner notes that claim 37 sets forth a guardrail post comprising upper and lower post members (emphasis added), as opposed to upper and lower “posts” as currently argued by appellant; the only recitation of a post being that of the overall claimed assembly. In other words, claim 37 sets forth a single post that is composed of and defined by two members, i.e., an upper post member and a lower post member. Accordingly, all that is required of claim 37 is upper and lower members which, together, form a “post”. The language of claim 37 neither sets forth nor requires upper and lower posts. The use of “member” with “post” defines that such is an element of the overall formed post, and does not clearly and positively require individual upper and lower posts.

As to claim 40, Wilcox discloses a breakaway guardrail post **10** capable of use with highway crash control systems comprising:

an upper post member **24,26** having a weak impact axis and a strong impact axis;

a lower post member **12** disposed beneath and spaced apart from the upper post member (lower member **12** together with upper member **24,26** form post **10**; thus lower member **12** constitutes a "post member"; Figure 1);

a connecting joint member **30,32** having a first end and a second end, the first end of the joint member connected at the first end by a first fastener **40,42** to the upper post member and connected at the second end by a second fastener to the lower post member (joint member **30,32** is connected by a weld to lower post member **12**; column 1 lines 62-65. Such weld constitutes a fastener as is consistent with the Board of Patent Appeals and Interferences' interpretation of the term "fastener" within the BPAI decision dated March 23, 2007.), the first fastener having a first failure strength less than a second failure strength of the second fastener;

the first fastener having a first connector **40** having a first failure strength and a second connector **42** having a second failure strength; and

the first failure strength of the first connector greater than the second failure strength of the second connector such that upon an impact force being applied along the weak impact axis, the second connector fails and the upper post member rotates about the first connector (Figures 1-6).

Examiner notes that claim 40 claims a guardrail post comprising upper and lower "post members", opposed to upper and lower "posts"; the only recitation of a post being that of the overall claimed assembly. Accordingly, all that is required of claim 40 is upper and lower members which together form a post. The phrase "post member" as

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used defines elements of the overall formed post, and does not clearly and positively claim individual upper and lower posts.

(10) Response to Argument

Appellant's arguments filed March 29, 2010 have been fully considered but they are not persuasive.

As to claims 37 and 40, appellant's sole argument is that Wilcox does not anticipate the claims because the post of Wilcox does not possess upper and lower posts (which have been argued, but not defined in the claim, to be uprights). This is not persuasive because such argument is not commensurate with the scope of the claims. In particular, it is pointed out that claim 37 sets forth upper and lower post "members", not posts. While a "post" clearly constitutes a "post member", the recitation of "post member" is not limited to only "posts". Rather, "post member" is inclusive of any member that is a constituent part of a "post". Thus, appellant is presenting an argument that is much more limiting than the actual claim language, itself. It is well-established that limitations not appearing in the claims cannot be relied upon for patentability. See *In re Self*, 671 F.2d 1344, 1348 (CCPA 1982).

The identified "lower post member", i.e., base **12**, of Wilcox is properly considered to constitute the lower post member as recited by claim 37 because it is a constituent part of the "post" and it is at the lower part of the overall "post". Nothing in the claim precludes this interpretation and thus the language of the claim "reads on" the device disclosed by Wilcox. Appellant's reliance on the specification to impact to the claim limitations not otherwise recited therein is insufficient.

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(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/Michael P. Ferguson/
Primary Examiner, Art Unit 3679

Conferees:

Daniel P. Stodola /dps/

Heather Shackelford /hcs/